



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : Attorney Docket No. 2007_0365
Tsuneo YASUMA et al. : Confirmation No. 1184
Serial No. 10/558,846 : Group Art Unit 1625
Filed November 30, 2005 : Examiner Nizal Chandrakumar
CONDENSED RING COMPOUND : Mail Stop: ISSUE FEE

SUPPLEMENTAL REQUEST FOR
RECONSIDERATION OF THE PATENT TERM ADJUSTMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Further to the Request for Reconsideration of Patent Term Adjustment filed February 16, 2010, upon further review of 37 CFR §1.705(d), which requires Applicants to raise any issues that could have been raised in an application for Patent Term Adjustment under 37 CFR §1.705(b), and in view of *Wyeth v. Kappos*, No. 2009-1120 (Fed. Cir. 2010), Applicants respectfully request reconsideration of the Patent Term Adjustment indicated on the Notice of Allowance under 37 CFR § 1.705(b) in view of the following remarks.

The relevant dates as specified in §§ 1.703 (a)-(e) are as follows:

USPTO Delay

"A" Delay

Under 37 CFR § 1.703(a)(1), the period of adjustment under § 1.702(a) includes the number of days in the period beginning on the day after the date that is fourteen months after the date on which the application was filed under 35 U.S.C. § 111(a) or fulfilled the requirements under 35 U.S.C. § 371 and ending on the date of mailing of either an action or a notice of allowance, whichever occurs first.

U.S. Serial No. 10/558,846 is a national phase filing of international patent application no. PCT/JP2004/007770, filed May 28, 2004. All of the requirements of 35 U.S.C. § 371 were fulfilled on **November 30, 2005**, and 14 months after November 30, 2005 is **January 30, 2007**. Applicants received a first Office Action on **November 16, 2007, which was 290 days after January 30, 2007**. Thus, the delay under 37 CFR § 1.703(a)(1) is **290 days**.

Under 37 CFR § 1.703(a)(2), the period of adjustment under § 1.702(a) includes the number of days in the period beginning on the day after the date that is four months after the date a reply under § 1.111 was filed and ending on the date of mailing of either an action or a notice of allowance, whichever occurs first.

A non-final Office Action was issued on April 9, 2009, and a response to the Office Action was timely filed on July 9, 2009. A notice of allowance was mailed on November 16, 2009, which was 4 months and 7 days after the response was filed. Therefore, the USPTO delay under 37 CFR § 1.703(a)(2) is **7 days**.

Under § 1.703(a)(1), the USPTO delay is 290 days, and under § 1.703(a)(2), the delay is 7 days. However, because the delay under § 1.703(a)(2) of 7 days occurred after a Request for Continued Examination (RCE) was filed (February 2, 2009), these days are excluded in accordance with *Wyeth v. Kappos*.

Accordingly, the total number of days of USPTO delay under § 1.703(a) is 290 days.

"B" Delay

The period of adjustment under 37 CFR § 1.703(b)(1) is the number of days in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. § 111(a) or the national stage commenced under 35 U.S.C. § 371(b) or (f) in an international application and ending on the date a patent was issued, but not including the number of days in the period beginning on the date on which an RCE was filed and ending on the date the patent was issued.

U.S. Serial No. 10/558,846 is a national phase filing of international patent application no. PCT/JP2004/007770, filed May 28, 2004, which claims priority to JP 2003-153986, filed **May 30, 2003**. The commencement of the national stage of the present application is 30 months after the Japanese priority application. Thus, the commencement of the national stage is

November 30, 2005. Three years after this date is **November 30, 2008.** An RCE was filed on February 2, 2009, which is 64 days after November 30, 2008.

Accordingly, the total number of days of USPTO delay under § 1.703(b) is 64 days.

Applicant Delay

Under 37 CFR § 1.704(a) and (b), the period of adjustment of the term of a patent under 37 CFR §1.703(a)-(e) shall be reduced by a period equal to the period of time during which applicant failed to engage in reasonable efforts to conclude prosecution of the application. An applicant shall be deemed to have failed to engage in reasonable efforts to conclude examination for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office in making a rejection.

A non-final Office Action was issued on February 11, 2008, setting a shortened statutory period for response of Sunday, May 11, 2008. A response to the Office Action was filed in the USPTO on Monday, May 12, 2008. Because a response to the Office Action was filed on the first business day following the due date of May 11, 2008, the response was timely filed under MPEP § 710.05. Therefore, Applicant did not delay in responding to the Office Action issued February 11, 2008.

A final Office Action was issued August 1, 2008, setting a shortened statutory period of response of November 1, 2008. An RCE was filed February 2, 2009, which was **93 days after November 1, 2008.** This constitutes a delay by Applicants under 37 CFR § 1.704 for failing to engage in reasonable efforts to conclude prosecution of the application. **Thus, Applicants caused a delay under 37 CFR § 1.704 of 93 days.**

Under 37 CFR 1.704(d), a paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application if it is accompanied by a statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement.

Each item of information cited in the IDS on October 2, 2009 was first cited in a Supplementary European Search Report issued August 21, 2009 in connection with corresponding European Application No. 04 74 5580, and this communication was received September 4, 2009 by Takashima P.O. A letter from the European Associate to Takashima P.O. showing the date of receipt of the European Search Report in Takashima P.O. was submitted with the Request filed February 16, 2010. Thus, each item of information contained in the IDS was not received by any individual designated in § 1.56(c) more than 30 days prior to the filing of the IDS in the USPTO. Therefore, the filing of the IDS does not constitute a failure to engage in reasonable efforts to conclude prosecution of the application under paragraph 37 CFR § 1.704(c)(8).

Accordingly, the total delay by Applicants under 37 CFR § 1.704(a) is **93 days**.

Correct Calculation of PTA

The total USPTO delay under 37 CFR § 1.703(a) is **290 days**.

The total USPTO delay under 37 CFR § 1.703(b) is **64 days**.

The total Applicant delay under 37 CFR § 1.704(a) is **93 days**.

Therefore, the total PTA is the number of days of USPTO delay minus the number days of Applicant delay, which is: $290 + 64 - 93 = 261$ days.

Accordingly, the PTA should be 261 days.

The present application is not subject to a terminal disclaimer.

The appropriate fee was paid with the Request filed February 16, 2010.

Accordingly, Applicants respectfully request the Patent Term Adjustment to be corrected,
and the PAIR website to indicate a PTA of **261 days**.

Respectfully submitted,

Tsuneo YASUMA et al.

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March 1, 2010